

**REMARKS/ARGUMENTS**

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

**A. SUMMARY OF THIS AMENDMENT**

By the current amendment, Applicants basically:

1. Editorially amend the specification.
2. Amend claims 1 and 5.
3. Add new claims 8-15.
4. Respectfully traverse all prior art rejections.

**B. § 112, 2ND PARAGRAPH REJECTION**

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. *See Office Action, page 2.* To address this issue, independent claim 1 is amended to provide sufficient antecedent basis for the feature as recited in claim 2. Applicants respectfully request that the rejection of claim 2 based on § 112, second paragraph, be withdrawn.

**C. § 102 REJECTION – TAKASHIMA**

Claims 1, 2, 5 and 7 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Takashima et al. (U.S. Patent 5,913,095). *See Office Action, pages 2-4.* Applicants respectfully traverse.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02*. Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Takashima et al. does not disclose each and every claimed element. For example, independent claim recites, in part “wherein the side wall member is arranged to be in the laid flat state automatically when the recording medium is longer in the recording medium discharge direction than the recording medium placement surface” and “wherein the side wall member is arranged to be in the upright state automatically when the recording medium is not longer in the recording medium discharge direction than the recording medium placement surface.” Takashima et al. does not disclose these features.

Takashima et al. is directed toward an image forming apparatus of the type including a paper cassette loaded with a stack of papers and a tray or similar paper stacking means for stacking the papers sequentially driven out via a paper outlet form in the casing of the apparatus. *See column 1, lines 4-10*. In the Office Action, it is alleged that the moveable tray portion 21 as illustrated in Fig. 9 is equivalent to the side wall member as claimed. In Takashima et al., it is disclosed that the moveable tray portion 21 is rotatable about a shaft 23 relative to the tray or sheet stacking section 40 in a direction indicated by an arrow E. The purpose of a moveable tray portion is so that

when papers to be dealt with are relatively long in the paper discharge direction or are easily collapsible, the moveable tray portion 21 is rotated to prevent the papers from collapsing in the paper stacking section 20A. *See column 6, lines 10-19.* It is noted that the moveable tray portion 21 must be manually operated to be in a proper position to receive the papers P.

There is no disclosure in Takashima et al. to suggest that the moveable tray portion 21 automatically switches between the upright state and the closed state depending on the size of the recording medium. For this reason alone, independent claim 1 is distinguishable over Takashima et al.

Claims 2, 5 and 7 depend from independent claim 1 directly or indirectly, and recite further distinguishing features. Accordingly, these dependent claims are also distinguishable over Takashima et al.

Applicants respectfully request that the rejection of claims 1, 2, 5 and 7 based on Takashima et al. be withdrawn.

#### **D. § 103 REJECTION – TAKASHIMA**

Claim 3 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takashima et al. *See Office Action, pages 5-6.* Applicants respectfully traverse.

Claim 3 depends from independent claim 1 and it is demonstrated that claim 1 is distinguishable over Takashima et al. Due to the dependency thereon, claim 3 is also distinguishable over Takashima et al.

Regarding the feature of “wherein the side wall member is configured such that when a recording medium has been discharged to the discharge space in the upright state that closes the open portion, the upright state changes to the laid flat state only upon receiving an external force from the recording medium.” In the Office Action, it is impliedly admitted that Takashima et al. does not disclose this feature. To correct this deficiency of Takashima et al., the Office Action simply alleges that it is well known in the art to incorporate such feature. In effect, an Official Notice is taken with regard to this feature.

First, Applicants respectfully disagree. Second, Applicants respectfully request that proper prior art references be cited in support of the position taken as required in MPEP 2144.03.

Applicants respectfully request that the rejection of claim 3 based on Takashima et al. be withdrawn.

**E. § 103 REJECTION – TAKASHIMA, FUKAI**

Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takashima et al. in view of Fukai (U.S. Patent 6,237,485). *See Office Action, pages 6-7.* Applicants respectfully traverse.

Claim 4 depends from independent claim 1 and it is demonstrated that claim 1 is distinguishable over Takashima et al. Fukai does not correct the above noted deficiencies of Takashima et al. Therefore, independent claim 1 is

distinguishable over the combination of Takashima et al. and Fukai. It then naturally follows that claim 4 is also distinguishable over the combination of Takashima et al and Fukai.

Regarding claim 4 itself, the claim recites, in part “wherein the side wall member is configured to go into the laid flat state prior to a discharge operation of a recording medium only when a discharge direction length dimension of the recording medium ... is longer than a length of a recording medium placement surface of the discharge space.” In the Office Action, it is admitted that Takashima et al. does not disclose this feature.

To correct these deficiencies of Takashima et al., the Office Action alleges that Fukai teaches a paper length sensors are inherently used with a type of microcontroller and are used to measure the recording medium and in response allow the controller to control a moving/actuating device to pivot the side wall member into the laid flat state resulting in automated control. This is insufficient to demonstrate inherency.

It is well established that the fact that a certain result or characteristic may occur or be presented is not sufficient to establish the inherency of that result or characteristic. In relying upon the theory of inherency, the Office Action must demonstrate that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *See MPEP 2112*.

In this instance, it is alleged that the mere presence of a paper length sensor is enough to demonstrate inherency of the feature as recited in claim 4.

This is not necessarily so. There may be many other reasons for the presence of the paper length sensor other than to automatically control a side wall member. The Fukai reference is an example of other possible uses for detecting the paper side. Fukai discloses that paper sizes are determined to prevent paper jams and the like. *See column 18, line 43-53.* Thus, contrary to the allegation in the Office Action, mere presence of a paper length sensor is not enough to demonstrate inherency of the feature as recited in claim 4.

Due to at least the above stated reasons, Applicants respectfully request that the rejection of claim 4 based on Takashima et al. and Fukai be withdrawn.

**F. § 103 REJECTION – TAKASHIMA, ISHIKAWA**

Claim 6 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takashima et al. in view of Ishikawa et al. (U.S. Patent 4,838,534). *See Office Action, pages 7-8.* Applicants respectfully traverse.

Claim 6 depends from independent claim 1 and it is demonstrated that claim 1 is distinguishable over Takashima et al. Ishikawa et al. does not correct the above noted deficiencies of Takashima et al. Therefore, independent claim 1 is distinguishable over the combination of Takashima et al. and Ishikawa et al. Claim 6 recites further distinguishing features. Accordingly, claim 6 is also distinguishable over the same combination of references.

Applicants respectfully request that the rejection of claim 6 based on Takashima et al. and Ishikawa et al. be withdrawn.

#### **G. NEW CLAIMS**

Claims 8-15 are added through this reply. All new claims are believed to be distinguishable over the cited references, individually or in any combination. For example, independent claim 8 recites, in part “wherein the side wall member is arranged to be automatically in a substantially upright closed state when a length of the recording medium discharged ... is less than a length of the recording medium placement surface” and “wherein the side wall member is arranged to be automatically in a substantially laid flat open state when the length of the recording medium ... is greater than the length of the recording medium placement surface.” It is demonstrated above that none of the cited references can be relied upon to disclose this feature.

Independent claim 13 recites, in part “determining whether the recording medium is longer in the recording medium discharge direction than the recording medium placement surface” and “opening the side wall member to be in a laid flat state when it is determined that the recording medium is longer.” It is respectfully submitted that none of the cited references disclose these features.

Claims 9-12 and 14-15 depend from independent claims 8 and 13, and recite further distinguishing features.

Applicants respectfully request that the new claims be allowed.

#### **H. CONCLUSION**

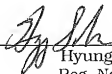
All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_



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